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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/749,408	12/28/2000	Nicholas Sauriol	56130.000067	5257

7590

09/06/2006

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EXAMINER

ELISCA, PIERRE E

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/749,408

Applicant(s)

SAURIOL ET AL.

Examiner

Pierre E. Elisca

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to Applicant's response filed on 06/29/2006.
2. Claims 1-12 are pending.
3. The rejection to claims 1, 3-5 and 7-12 under 35 U.S.C. 103 (a) as being unpatentable over Foster in view of Segal and to claims 2 and 6 as being unpatentable over Foster in view of Weber as set forth in the office action mailed on 03/29/2006 is maintained.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1, 3, 4, 5, 7 and 8-12 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Foster in view of Segal et al (U.S. Pat. No. 6,820,804).**As per claims 1, 3, 4, 5, 7 and 8-12 Foster substantially discloses a financial transaction system such that Applicants' step of providing a secured network that stores consumer data and approved vendor information, Applicants' step of receiving transaction information at the secured network, and Applicants' step of processing the transaction information to determine whether the transaction information conforms with the stored consumer data and approved vendor information reads on col 8, lines 19-28, and

applicants' step of delivering the stored consumer data to the vendor if the transaction information is determined to conform with the stored consumer data and approved vendor information reads on the message to the merchant, from the system, of the cardholder's shipping address, col 8, lines 47-50.

Foster fails to explicitly disclose Applicant's newly added limitation wherein said receipt of the stored consumer data by the vendor enables the vendor to receive payment for the e-commerce transaction. However, Segal discloses a system/method for performing a purchase transaction in which a consumer provides a merchant with a credit card for payment. The merchant then uses the credit card number to debit the credit card account of the consumer. The consumer signs a receipt evidencing the transaction. The merchant keeps the original signed receipt and gives the consumer a copy of the signed receipt. The signed receipts are evidence of proof of purchase for both the consumer and the merchant (see., Segal, col 1, lines 14-28). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the financial transaction of Foster by including the limitation detailed above as taught by Segal because this would allow an authorized person to act on behalf of the consumer and purchase goods or services.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2 and 6 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Foster in view of Weber et al (U.S. Pat. No. 6,178,409).

Although Foster does not explicitly disclose the use of a VPN, Weber discloses a virtual private network between a gateway and a host processor that is established to expedite host communication (see., col 91, lines 50-61). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of foster to utilize a virtual private network as VPN is known to provide greater security when performing transactions.

RESPONSE TO ARGUMENTS

8. Applicant's arguments have been fully considered but they are not persuasive.

REMARKS

9. In response to Applicant's arguments filed on 06/29/2006, Applicant argues that the prior art of record (Foster) does not disclose or suggest:

a. a secured network. However, the Examiner respectfully disagrees with this assertion since Foster discloses an order verification reply target (OVRT) for verifying a cardholder and a merchant transactions, and therefore is readable as a verification means (or secured network) for delivering secure transactions to the merchant and the cardholder .see., col 8, lines 12-59.

b. Applicant also argues that Segal does not disclose or suggest receipt of the stored consumer data by the vendor enables the vendor to receive payment for the e-commerce transaction. However, Segal discloses a system/method for performing a purchase transaction in which a consumer provides a merchant with a credit card for payment. The merchant then uses the credit card number to debit the credit card account of the consumer. The consumer signs a receipt evidencing the transaction. The merchant keeps the original signed receipt and gives the consumer a copy of the signed receipt. The signed receipts are evidence of proof of purchase for both the consumer and the merchant (see., Segal, col 1, lines 14-28). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the financial transaction of Foster by including the limitation detailed above as taught by Segal because this would allow an authorized person to act on behalf of the consumer and purchase goods or services.

c. Applicant further argues that the Office action has failed to set forth a prima facie case of obviousness for the claims. The Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. In re Fine, 837 F.2d 1071, 5USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also In re Eli Lilly & Co., 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); In re Nilssen, 851 F.2d 1401, 7USPQ2d 1500 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings); Ex parte Clapp, 227 USPQ 972 (Bd. Pat. App. & Inter); and Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning).

Also in reference to Ex parte Levengood, 28 USPQ2d, 1301, the court stated that "Obviousness is a legal conclusion, the determination of which is a question of patent law.

Motivation for combining the teachings of the various references need not to explicitly found in the reference themselves, In re Keller, 642 F.2d 413, 208USPQ 871 (CCPA 1981). Indeed, the Examiner may provide an explanation based on logic and sound scientific reasoning that will support a holding of obviousness. In re Soli, 317 F.2d 941 137 USPQ 797 (CCPA 1963)."

Conclusion

10. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 571 272 6706. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571 272 6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 09/749,408

Page 8

Art Unit: 3621



Pierre Eddy Elisca

Primary Patent Examiner

August 22, 2006